

REMARKS

Reconsideration of the application in light of the following remarks is respectfully requested.

Claims 1-8 are pending. Claim 1 has been amended in an idiomatic nature, and sets forth the properties of the recited structure without narrowing the subject matter contained therein. No new matter has been added.

Claims 1-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Interactive Layout Mechanisms for Image Database Retrieval*, John MacCuish, et al., SPIE 104-115, vol. 2656, January 1996 (“MacCuish”) in view of U.S. Patent No. 6,219.053 to Tachibana et al. (“Tachibana”). Applicant respectfully traverses the rejection.

The Examiner contends that MacCuish discloses most of the features of claims 1-8. However, the Examiner acknowledges that MacCuish fails to disclose “the control means to select an arbitrary position on the display unit that upon selection displays or removes an icon related to a database element where its degree of dissimilarity to other icons corresponds with the distances between the icons,” and further fails to disclose “the mutual positioning of icons on the display in concurrence with the dissimilarity of the elements from the database.” (Detailed Action, item 4, page 2.) The Examiner cites Tachibana (column 2, lines 42-52, and column 1, lines 1-5, respectively) as disclosing those features acknowledged to be missing from MacCuish. The Examiner states that it would have been obvious to a person of ordinary skill in the art to combine MacCuish and Tachibana to achieve the invention of claims 1-8.

Applicants submit that Tachibana, column 2, lines 42-52, discloses an apparatus that draws icons corresponding to objects, where the correlation between objects is taken into account in computing the correlated positions of the icons. This passage describes in general terms the embodiment of Tachibana, Fig. 4, which is explained at column 6, line 23-45. Column 6 clearly discloses that the user interface displays elements at varying distances based on their correlation from a root element. Tachibana discloses displaying icons indicating hierarchical levels, where “the

icon indicating the root of the first hierarchical level is a currently regarded node, and is positioned in the center” (Tachibana, column 6, lines 24-26.) Tachibana discloses that the other icons are positioned relative to the icon which indicates “the root of the first hierarchical level.”

Claim 1 is directed to an electronic database search engine that includes a control means for controlling a user interface, where the user interface allocates icons to the elements of the database, which icons are suitable for display on a display. Claim 1 recites that “the control means selects any arbitrary position on the display unit” and that an icon relates to an element of the database where “the degree of dissimilarity, in respect of the elements whose corresponding icons are displayed elsewhere on the display unit, corresponds with the distance taken up by the selected position in relation to the icons displayed elsewhere on the display unit.” Clearly, the claimed invention selects any arbitrary position on the display unit. Further, the user interface, depending on the control means, displays or removes an icon that relates to any possible element of the database of which the selected arbitrary position corresponds to the degree of dissimilarity with the other elements.

In contrast to disclosing displaying an icon at any arbitrary position on the display unit, Tachibana discloses “an icon indicating the root of the first hierarchical level . . . positioned in the center” and that other icons are positioned relative to this root icon. Tachibana does not disclose, or suggest, “an arbitrary position . . . selected on the display unit” and the display of “the degree of dissimilarity, in respect of the elements whose corresponding icons are displayed elsewhere on the display unit,” as recited in claim 1.

The Examiner acknowledges that MacCuish neither discloses nor suggests the features of claim 1 which Applicants have demonstrated are missing from Tachibana. Independent claim 5 is directed to a method and recites steps which implement the novel features of claim 1 as discussed above. Therefore, MacCuish and Tachibana neither disclose nor suggest all the features of claims 1 and 5.

In considering obviousness, the critical inquiry is whether something in the prior art as a whole suggests the desirability, and thus the obviousness, of making a combination. *In re Newell*, 891 F.2d 899, 901-02, 13 U.S.P.Q. 2d 1248, 1250 (Fed. Cir. 1992). The Examiner must show some objective teaching from the art that would lead an individual to combine the references, *i.e.*, there must be motivation. In particular, “[t]he mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” (Emphasis added). *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992). The Court of Appeals for the Federal Circuit has stated: “selective hindsight is no more applicable to the design of experiments than it is to the combination of prior art teachings. There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the Applicant's disclosure.” *In re Dow Chemical Co.*, 5 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1988) (citations omitted).

Applicant submits there is no suggestion in MacCuish or Tachibana to combine these references. Instead, the Examiner has impermissibly relied on the disclosure of the present application “to reconstruct the patentee's claimed invention from prior art by using the patentee's claim as a ‘blueprint’ when prior art references require selective combination to render obvious a subsequent invention.” (*Dow Chemical Co.*, 5 U.S.P.Q. 2d at 1532, *citing Interconnect Planning Corporation v. Feil*, 774 F.2d 1132, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985).)

Applicants respectfully submit that the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness over claims 1 and 5. Claims 2-4 depend from claim 1. Claims 6-8 depend from claim 5. Applicants submit that the Examiner has failed to meet the burden of establishing a *prima facie* over claims 2-4 and 6-8 for at least the same reasons as their respective base claims. Reconsideration and withdrawal of the rejection is requested.

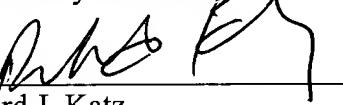
CONCLUSION

Each and every point raised in the Final Office Action mailed January 4, 2005 has been addressed on the basis of the above amendments and remarks. In view of the foregoing it is believed that claims 1-8 are in condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

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Respectfully submitted,

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